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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re James T. Maher

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Serial No. 75/934,176

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Christopher L. Buongiorno, Trademark Examining Attorney,  
Law Office 109 (Leslie Bishop, Managing Attorney).

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Before Hairston, Bottorff and Drost, Administrative  
Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

On March 2, 2000, James T. Maher (applicant) applied to register the mark RAK RANDOM ACTS OF KINDNESS (typed) on the Principal Register for "shirts" in International Class 25. The application contained an allegation of a date of first use of April 13, 1999, and a date of first use in commerce of May 5, 1999.

The examining attorney refused to register applicant's mark on the ground that the mark is used on the goods as ornamentation and it, therefore, does not function as a mark under the provisions of Sections 1, 2, and 45 of the Trademark Act. 15 U.S.C. §§ 1051, 1052, and 1127. The examining attorney maintains that applicant's mark is a slogan "Random Acts of Kindness" with the letters "RAK" and that "[s]logans or phrases used on items such as t-shirts and sweatshirts, jewelry, and ceramic plates have been refused registration as ornamentation that purchasers will perceive as conveying a message rather than indicating source of the goods." Brief at 2-3. The examining attorney held that the mark is only ornamentation and that there is no evidence that applicant's mark serves a source-identifying function.

In response, applicant asserts that the "mark's overall commercial impression is that of a trademark" and that the specimens of record closely match examples of matter functioning as a trademark. Brief at 3. Applicant also maintains that the term RAK is very significant. "'RAK' is an acronym coined by the applicant standing for 'Random Acts of Kindness...' As such a coined acronym, the 'Rak' portion of the overall mark 'RAK RANDOM ACTS OF

KINDNESS' makes the mark more arbitrary in nature." Brief at 6.

After the examining attorney made the refusal final, this appeal followed.

The mere fact that a term appears on a product does not make it a trademark. In re Pro-Line Corp., 28 USPQ2d 1141, 1142 (TTAB 1993). Informational messages and slogans devoid of trademark significance are not inherently distinctive. Id. However, "[m]atter which serves as part of the aesthetic ornamentation of goods, such as T-shirts and hats, may nevertheless be registered as a trademark for such goods if it also serves a source-indicating function." In re Dimitri's Inc., 9 USPQ2d 1666, 1667 (TTAB 1988).

"Where, as here, an alleged mark serves as part of the aesthetic ornamentation of the goods, the size, location, dominance and significance of the alleged mark as applied to the goods are all factors which figure prominently in the determination of whether it also serves as an indication of origin." Pro-Line, 28 USPQ2d at 1142.

An important function of specimens in a trademark application is, manifestly, to enable the PTO to verify the statements made in the application regarding trademark use. In this regard, the manner in which an applicant has employed the asserted mark, as evidenced by the specimens of record, must be carefully considered in determining whether the asserted mark has been used as a trademark with respect to the goods named in the application.

In re Bose Corp., 546 F.2d 893, 192 USPQ 213, 216  
(CCPA 1976) (emphasis in original, footnote omitted).

A specimen showing three photographs of the fronts of  
applicant's shirts is set out below.



The photographs show that the words are prominently featured as ornamentation on the front of applicant's shirts in either the center or the left corner. The term RAK is always shown in larger type than the other words, "Random Acts of Kindness." After viewing the specimens, we cannot agree with applicant that its mark creates the commercial impression of a trademark. The mark is displayed on the front of the shirts in a manner that "immediately catches the eye." Pro-Line, 28 USPQ2d at 1142. The size, location, and dominance of applicant's mark on the shirts supports the conclusion that the mark would serve an ornamental rather than a source-identifying function on the goods.

In addition, the words in the mark itself do not indicate that they would have anything other than an ornamental significance. Certainly the common words, "random acts of kindness" would not be inherently distinctive when applied to shirts as applicant has done. It is a phrase akin to the non-distinctive phrases discussed in In re Olin Corp., 181 USPQ 182 (TTAB 1973) ("Swallow Your Leader") and in Damn I'm Good Inc. v. Sakowitz, 514 F. Supp. 1357, 212 USPQ 684 (S.D.N.Y. 1981) ("Damn I'm Good"). The only unusual feature of applicant's mark is the fact that it includes the term "RAK." Standing

alone, "RAK" may not appear to have any meaning, however, the next part of applicant's mark answers any questions that prospective purchasers may have concerning the meaning of this term. The mark immediately defines the term as an acronym for the non-distinctive words "random acts of kindness." Applicant admits that "RAK" is "an acronym coined by applicant standing for 'Random Acts of Kindness,'" (Brief at 6) and customers would clearly understand the term to have this meaning. When consumers view the mark as used on the specimens, the mark is not arbitrary. Instead, it would be viewed as an informational message or a slogan devoid of trademark significance. Pro-Line, 28 USPQ2d at 1142.

In addition, applicant also admits that other slogans appear on the back of applicant's shirts, such as "It's good for the soul" and "Give a little, get a lot." Brief at 5. This fact makes it even less likely that potential customers will sort through the slogans on the front and back of applicant's shirts and ascribe trademark functions to some and ornamental or decorative functions to others.<sup>1</sup>

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<sup>1</sup> We note that applicant does not use the TM symbol after its mark, although it does use the TM symbol after the word RAK. This is some evidence that potential customers will not recognize the actual mark for which that applicant is currently seeking registration as a trademark. In re Wakefern Food Corp., 222 USPQ 76, 78-79 (TTAB 1984) ("The fact that no symbol, such as 'TM' or 'SM,' is used to designate an alleged mark is also some

Rather, prospective purchasers will see that applicant's shirts contain various messages or other non-distinctive phrases.

We also observe that the record is devoid of any evidence that consumers recognized that applicant's mark has a source-identifying function. There is no evidence to suggest that applicant's term identifies a secondary source in addition to being ornamental. Our case law recognizes that the ornamentation of "a T-shirt can be of a special nature which ... inherently tells the purchasing public the source of the T-Shirt, not the source of manufacture but the secondary source. Thus, the name New York University and an illustration of the Hall of Fame, albeit it will serve as ornamentation on a T-Shirt will also advise the purchaser that the university is the secondary source of that shirt." In re Paramount Pictures Corp., 213 USPQ 1111, 1112 (TTAB 1982). In that case, the Board found that the "*primary* significance of the words "MORK & MINDY" to any prospective purchaser of a decal such as the one here involved is to indicate the television series." Id. (emphasis in original). The Board went on to discuss that

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evidence that the phrase is not being used in a trademark or service mark sense"). See also In re Astro-Gods Inc., 223 USPQ 621, 624 (TTAB 1984) (Use of copyright notice with ornamentation not enough to make an association between the designation and applicant's name).

arbitrary terms such as KODAK and DREFT have obvious source-indicating characteristics because they "usually have no other perceived significance." Id. In this case, there is no evidence that RAK would be recognized in a similar manner as MORK & MINDY, DREFT, or KODAK. Second, as we indicated earlier, the mark itself defines the term RAK in such a way that prospective purchasers would simply associate RAK with the non-distinctive phrase "Random Acts of Kindness" rather than as an arbitrary term.

In conclusion, it is our view that the words sought to be registered are primarily an ornamental feature of the goods and, therefore, they do not function as a trademark for the goods.<sup>2</sup>

Decision: The refusal to register is affirmed.

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<sup>2</sup> Applicant has not sought registration under the provisions of Section 2(f) of the Trademark Act.